



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,086	09/26/2000	Yuji Sawada	55168(55)	4078

21874 7590 01/09/2008
EDWARDS ANGELL PALMER & DODGE LLP
P.O. BOX 55874
BOSTON, MA 02205

EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
----------	--------------

3625

MAIL DATE	DELIVERY MODE
-----------	---------------

01/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/647,086

Applicant(s)

SAWADA ET AL.

Examiner

Matthew S. Gart

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-19, 29 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date see Office Action.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/14/2007 has been entered.

Prosecution History Summary

- Claims 1-30 are pending in the instant application.
- Claims 1-19 and 29-30 were withdrawn from consideration.
- Claims 20-28 constitute the claims under active prosecution in this application.

Information Disclosure Statement

The information disclosure statements submitted on September 12, 2007, October 4, 2007, March 5, 2007, October 5, 2006, and April 20, 2005 were considered by the Examiner.

Priority

The Applicant argues that the Examiner has failed to reconfirm or re-acknowledge certain aspects relating to patent examination (pages 21-22 of remarks).

The Examiner notes, reconfirmation and re-acknowledgement are not required. Once the Examiner makes notes of certain formal matters, said notations are incorporated into the prosecution history.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 20-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Fujimoto (U.S. Patent No. 6,018,720).

Referring to claim 20. Fujimoto discloses a data reproducing apparatus reproducing digital data including reproducing apparatus specifying information specifying an apparatus capable of reproduction, comprising:

a housing containing:

a storage apparatus storing reproduction apparatus ID information unique to said reproducing apparatus (Fig. 2, "13");

means for reading out said digital data from said storage media, wherein said media includes a data region storing said reproducing apparatus specifying information (column 9, lines 40-64);

a first determining apparatus determining whether said reproducing apparatus is capable of reproducing said digital data from said reproduction apparatus ID information and said reproducing apparatus specifying information (column 11, lines 23-45);

a control apparatus enabling or disabling reproduction of digital data by said reproducing apparatus dependent on the result of determination by said first determining apparatus (column 13, lines 19-49) and

a CPU directly controlling the manner of operation of said storage apparatus, said first determining apparatus, and said control apparatus as well as the reproduction of said digital data enabled by said control apparatus as audio and/or video signals (Fig. 1, "24").

Referring to claim 21. Fujimoto further discloses a data reproducing apparatus wherein:

said digital data includes display data to be reproduced visually (column 8, lines 15-48); and

said reproducing apparatus comprises a display apparatus for visually reproducing and displaying said digital data (column 8, lines 15-48).

Referring to claim 22. Fujimoto further discloses a data reproducing apparatus further comprising an ID information input apparatus responsive to determination by said first determining apparatus that said reproducing apparatus is not a reproducing apparatus capable of reproducing said digital data, urging a user to enter a reproducing

apparatus ID information (column 11, lines 23-45).

Referring to claim 23. Fujimoto further discloses a data reproducing apparatus comprising:

a second determining apparatus determining whether the data reproducing apparatus specified by the reproducing apparatus ID information input by said ID information input apparatus is a reproducing apparatus capable of reproducing said digital data; wherein said control apparatus enables or disables reproduction of digital data by said reproducing apparatus dependent on the result of determination by said second determining apparatus (column 11, lines 23-45 and column 13, lines 19-49).

Referring to claim 24. Fujimoto further discloses a data reproducing apparatus comprising:

an update selecting apparatus responsive to the determination by said second determining apparatus that the data reproducing apparatus specified by the reproducing apparatus ID information input by said ID information input apparatus is a reproduction apparatus capable of reproducing said digital data, allowing the user to select whether said reproducing apparatus specifying information is to be updated by said input reproducing apparatus ID information (column 13, line 49 through column 14, line 5); and

an updating apparatus responsive to the selection, by said update selecting apparatus that said reproducing apparatus specifying information is to be updated by said

reproducing apparatus specifying information by said input reproducing apparatus ID information (column 13, line 49 through column 14, line 5).

Referring to claims 25-26. Claims 25-26 are rejected under the same rationale as set forth above in claims 20-24.

Referring to claim 27. Fujimoto further discloses a data reproducing apparatus wherein said reproducing apparatus specifying information is recorded when reproduction is first performed by the data reproducing apparatus (abstract).

Referring to claim 28. Fujimoto further discloses a data reproducing apparatus wherein said reproducing apparatus specifying information is recorded when the digital data is sold (abstract).

Application/Control Number:
09/647,086
Art Unit: 3625

Page 8

Response to Arguments

Applicant's arguments filed 11/14/2007 have been fully considered but are moot in view of the new grounds of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Montoya et al., U.S. Patent No. 5,949,688.

Christiansen et al., U.S. Patent No. 7,748,485.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Gart whose telephone number is 571-273-3955. The examiner can normally be reached on M-F, 9-6.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number:
09/647,086
Art Unit: 3625

Page 10

MSG
Primary Examiner
AU 3625



MATTHEW S. GART
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600